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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/729,621	12/05/2003	John J. Thrall	600189-057	2930

7590 04/19/2007  
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EXAMINER
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LEWIS, ALICIA M

ART UNIT	PAPER NUMBER
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2164

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/19/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/729,621	<b>Applicant(s)</b> THRALL, JOHN J.	
	<b>Examiner</b> Alicia M. Lewis	<b>Art Unit</b> 2164	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 February 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 4-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f):
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
**SAM RIMELL**  
**PRIMARY EXAMINER**

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

This office action is responsive to the Request for Continued Examination (RCE) filed February 20, 2007. No additional changes have been made to the claims, since the amendments submitted July 24, 2006. Therefore, claims 1, 2 and 4-25 remain pending in this application.

### ***Claim Rejections - 35 USC § 101***

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1, 2, and 4-18 and 25 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

2. Claims 1, 2 and 4-18 and 25 are directed to a method of scoring data for use in a search engine. This claimed subject matter lacks a practical application of a judicial exception (law of nature, abstract idea, naturally occurring article/phenomenon) since it fails to produce a useful, concrete and tangible result.

Specifically, the claimed subject matter does not produce a tangible result because the claimed subject matter fails to produce a result that is limited to having real world value rather than a result that may be interpreted to be abstract in nature as, for example, a thought, a computation, or manipulated data. More specifically, the claimed subject matter provides for determining a user preference for a clicked data. This produced result remains in the abstract and, thus fails to achieve the required status of having real world value.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 1, 2, 4, 8-11, 13-16, 18-21, 23 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US Patent Application Publication 2005/0071255 A1) ('Wang') in view of Bem (US Patent Application Publication 2005/0080772 A1).

With respect to claims 1, 19 and 25, Wang teaches:

tracking clicks by users on data returned in a search result in response to a query (element 126 in Figure 1, paragraph 27 lines 3-5, paragraph 28 lines 1-4); and

determining a user preference for a clicked data in accordance with a physical position of the clicked data in the search result (paragraphs 26, 30, 34).

Wang does not explicitly teach determining a ratio of actual clicks to clicks expected for the clicked data and a specific query.

Bem teaches using match confidence to adjust a performance threshold (see abstract) in which he teaches determining a ratio of actual clicks to clicks expected for the clicked data and a specific query (paragraphs 75 lines 1-3 and 18-19, paragraphs 79-81, and paragraph 94).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified Wang by the teaching of Bem because determining a ratio of actual clicks to clicks expected for the clicked data and a specific query would enable an ad (search result) score to be adjusted using a score adjustment parameter, which takes into account a ratio of click-through data (paragraphs 59 and 79).

With respect to claims 2 and 20, Wang as modified teaches wherein determining a user preference for a clicked data is further performed in accordance with a number of clicks made by users on the data returned in the search result (Wang, paragraph 31 lines 6-9, paragraph 37 lines 1-3).

With respect to claim 4, Wang as modified teaches wherein determining a user preference is performed periodically (Wang, paragraph 31).

With respect to claims 8 and 21, Wang as modified teaches wherein determining a user preference for a clicked data in accordance with a physical position of the data in the search result is performed in accordance with weight values determined by observed user click behavior (Wang, paragraph 28).

With respect to claim 9, Wang as modified teaches wherein determining a user preference for a clicked data in accordance with a physical position of the data in the

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search result is performed in accordance with weight values determined by trial and error (Bem, paragraphs 71, 74 and 96).

With respect to claim 10, Wang as modified teaches wherein tracking clicks by users includes tracking: a query, a data fingerprint, and a position in the search results for a click on data from a search result for a specific query (Wang, paragraph 29).

With respect to claim 11, Wang as modified teaches wherein tracking clicks by users further includes tracking: a time the click occurred and user ID information (Wang, paragraph 29).

Because there are multiple users of the system, it is implied that user ID information is tracked (Wang, paragraph 28 lines 1-3).

With respect to claim 13, Wang as modified teaches further including normalizing the click information before the determining step (Wang, paragraph 33 lines 1-2).

With respect to claim 14 and 23, Wang as modified teaches wherein the data is image data (Wang, paragraph 27 lines 9-10).

With respect to claim 15, Wang as modified teaches wherein the data is shopping data (Wang, paragraph 27 lines 7-8).

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With respect to claim 16, Wang as modified teaches wherein the data is textual data (Wang, paragraph 27 lines 9-10).

With respect to claim 18, Wang as modified teaches wherein determining a user preference includes determining context dependent user preference scores in accordance with a characteristic of the users clicking on the search results (Wang, paragraph 35).

***Claim Rejections - 35 USC § 103***

5. Claims 5-7, 12, 17, 22 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wang et al. (US Patent Application Publication 2005/0071255 A1) ('Wang') in view of Bem (US Patent Application Publication 2005/0080772 A1) as applied to claims 1, 2, 4, 8-11, 13-16, 18-21, 23 and 25 above, and further in view of Golding et al. (US Patent 6,640,218 B1) ('Golding').

With respect to claim 5, Wang as modified teaches claim 1.

Wang as modified does not teach wherein determining a user preference is performed weekly.

Golding teaches estimating the usefulness of an item in a collection of information (see abstract), in which he teaches wherein determining a user preference is performed weekly (column 11 lines 53-60).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have further modified Wang by the teaching of Golding because wherein determining a user preference is performed weekly would enable a method do determine popularity measures of sets of criteria and to determine the overall popularity of an item, with respect to particulate period of time (Golding, column 2 lines 60-64, column 11 lines 53-60).

With respect to claim 6, Wang as further modified teaches wherein determining a user preference is performed in real time (Golding, column 11 line 65 – column 12 line 12).

With respect to claim 7, Wang as further modified teaches further comprising determining values in a weight table based on user preferences for physical positions within search results independent of a query (Wang, paragraphs 33-34, page 8 claim 4; Golding, column 4 lines 47-53, column 8 lines 61-62).

Golding teaches a relevance metric (weight) based on user preferences and Wang teaches adjusting a score to account for physical positions within search results.

With respect to claims 12 and 22, Wang as further modified teaches wherein determining a user preference further includes weighting click information so that clicks by users on data in unpopular positions in the search results migrate that data toward the top of future search results (Golding, column 7 lines 16-20).



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With respect to claim 17, Wang as further modified teaches further comprising using the determined user preference to determine rankings for display of future search results (Golding, column 2 lines 48-52).

With respect to claim 24, Wang as further modified teaches wherein determining a user preference uses a plurality of weight tables corresponding to ones of a plurality of user interfaces displaying the search result (Golding, column 3 lines 34-38, column 8 lines 64-67).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2 and 4-25 have been considered but are moot in view of the new ground(s) of rejection.

In the Final Rejection mailed November 16, 2006, there is a typo. The last sentence in the Response to Arguments section (page 7) read, "The record shows that Wang was owned by Overture Services, Inc." The sentence should have read, "The record shows that Wang was owned by **Yahoo, Inc.**"

Applicant has failed to produce evidence that shows that Wang is/was owned by Overture Services, Inc. Our record shows that the assignee for the Wang reference, US Patent Application Publication 2005/0071255 A1 (US Patent 7,130,819), is Yahoo, Inc. Therefore, there is no record of common ownership of the applications, thus Wang does qualify as prior art.

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**Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alicia M. Lewis whose telephone number is 571-272-5599. The examiner can normally be reached on Monday - Friday, 9 - 6:30, alternate Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on 571-272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

AML  
April 13, 2007

  
**SAM RIMELL**  
**PRIMARY EXAMINER**